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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,978	08/18/2003	Jay S. Walker	97-558-C1	3402
22927	7590	02/21/2006	EXAMINER [REDACTED]	O'CONNOR, GERALD J
WALKER DIGITAL 2 HIGH RIDGE PARK STAMFORD, CT 06905			ART UNIT [REDACTED]	PAPER NUMBER 3627
DATE MAILED: 02/21/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/642,978	Walker et al.	
	<b>Examiner</b>	<b>Art Unit</b>	
	O'Connor	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on November 30, 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-5 is/are pending in the application.  
 4a) Of the above claim(s) none is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-5 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on August 18, 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>20050816 and 20050818</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### *Preliminary Remarks*

1. This Office action responds to the amendment and arguments filed by applicant on November 30, 2005 in reply to the previous Office action on the merits, mailed June 28, 2005.
  
2. The amendment of independent claim 1 by applicant in the reply filed November 30, 2005 is hereby acknowledged.

### *Claim Rejections - 35 USC § 101*

3. The following is a quotation of 35 U.S.C. 101:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
  
4. Claims 1-5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-5 are drawn to a method of producing a disembodied data structure. It has been held that such claims are considered to comprise non-statutory subject matter, for *merely manipulating an abstract idea* without producing any “useful, concrete, and tangible result.” *In re Warmerdam*, 33 F.3d 1354; 31 USPQ2d 1754 (Fed. Cir. 1994).

As a suggestion to applicant, this rejection could be overcome by simply amending claim 1 to change “outputting” (line 5) to --outputting from the point-of-sale terminal--, as the claim currently *implies* (based on the specification), but does not currently *require*.

***Double Patenting - Nonstatutory***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

A registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,267,670. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are drawn to the same essential subject matter.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nilssen (US 5,083,784), in view of Burke (US 6,112,191).

Nilssen discloses a method of purchasing lottery tickets, the method comprising: determining a monetary value; allocating a portion of a ticket, the portion being based on the monetary value; outputting a ticket identifier that identifies the ticket and a portion identifier that identifies the allocated portion of the ticket; and, storing the ticket identifier and the portion identifier, but Nilssen fails to disclose determining the monetary value by use of a point-of-sale terminal.

However, Burke discloses using a point-of-sale terminal to determine a monetary value. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Nilssen so as to have the lottery purchase effected at a point-of-sale terminal, in accordance with the method of Burke, in order to facilitate the purchase by determining the monetary value by use of the point-of-sale terminal.

Regarding claim 2, Nilssen fails to disclose that the step of determining a monetary value is based on an amount of change due for a purchase. However, Burke discloses using an amount

of change to determine a monetary value for an added purchase. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have further modified the method of Nilssen so as to use an amount of change, in accordance with the teachings of Burke, to determine a monetary value for the lottery purchase of Nilssen, in order to make the lottery purchase as convenient as possible, hence as attractive/desirable as possible, thereby generating as many sales as possible.

Regarding claims 3-5, Nilssen fails to disclose the steps of : selecting the ticket from a plurality of tickets; selecting a ticket having an unallocated (available to purchase) portion at least as great as the monetary value (amount being purchased); and, determining a set of tickets that each have an unallocated (available to purchase) portion at least as great as the monetary value (amount being purchased) and selecting the ticket with the smallest unallocated portion within that set of tickets. However, such steps are self-evident, hence obvious, to those of ordinary skill in the art, since such steps comprise details that would all suggest themselves to one of ordinary skill in the art, simply by the nature of the problem to be solved, in the ordinary course of implementing a solution/design. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have further modified the method of Nilssen so as to perform any of the recited steps, simply as a matter of design choice, since such steps could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

***Response to Arguments***

9. Applicant's arguments filed November 30, 2005 have been fully considered but they are not persuasive.
10. Regarding the argument that the claims are drawn to statutory subject matter because the *specification discloses* statutory subject matter, it is noted that the arguments upon which applicant relies, i.e., "a useful, concrete, and tangible result (as described in the specification)," are *not required* by the rejected claim(s), which are drawn merely to production of a disembodied data structure. *It has been held* that such claims are considered to comprise non-statutory subject matter, for merely manipulating an *abstract idea* without producing any "useful, concrete, and tangible result." *In re Warmerdam*, 33 F.3d 1354; 31 USPQ2d 1754 (Fed. Cir. 1994). As far as the specification, although the claims are interpreted *in light* of the specification, limitations from the specification are not *read into* the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
11. Regarding the argument that the obviousness-type double patenting rejection failed to consider all of applicant's claim limitations, all of applicant's claim limitations were indeed properly considered, and none were ignored.
12. Regarding the argument that claims 1-12 of U.S. Patent No. 6,267,670 do not include the step of "allocating a portion of a ticket, the portion being based on the monetary value,"

claims 1-12 of U.S. Patent No. 6,267,670 indeed require, though recited using a different set of words, the step of “allocating a portion of a ticket, the portion being based on the monetary value,” since “allocating a portion of a ticket, the portion being based on the monetary value” is what necessarily occurs in the “method for performing a lottery ticket transaction at a point-of-sale terminal” in performing the recited step of “calculating a fractional amount of a full lottery ticket, the full lottery ticket having a full price, the fractional amount being based on the change amount and the full price,” in combination with the other recited steps for effecting the transaction, as set forth, for example, in claim 5 of the patent.

13. Regarding the argument that the obviousness-type double patenting rejection fails to set forth any motivation to modify the patent, no motivation is required because no modification is necessary. The instant claims are anticipated by the patent, since the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but need not be in the identical words as used in the claims in order to be anticipatory. See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

14. Regarding the argument that Nilssen fails to disclose “allocating a portion of a ticket, the portion being based on the monetary value,” Nilssen indeed discloses “allocating a portion of a ticket, the portion being based on the monetary value,” since the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but need not be in the

identical words as used in the claims in order to be anticipatory. See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

Additionally, note that, during patent examination, the pending claims must be interpreted as broadly as their terms reasonably allow. See *In re Zletz*, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

Lastly, note that it has been held, specifically, that applicant's recitation of "a portion of a ticket" includes a 100% portion (i.e., a whole, entire ticket). See *Ex Parte Walker et al.*, Appeal No. 2005-1570, Application No. 09/045,036, (BPAI 2005).

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to the disclosure.

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Alexander Kalinowski, can be reached at **(571) 272-6771**.

Official replies to this Office action may be submitted by any **one** of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (571) 273-8300**. Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

February 15, 2006



2/15/06

Gerald J. O'Connor  
Primary Examiner  
Group Art Unit 3627